

**AMENDMENTS TO THE DRAWINGS**

Please replace figures 1 and 2 with the following amended figures, which include the designation "Prior Art" and are labeled "Replacement Sheet".

**REMARKS**

Claims 1 and 4-10 are pending in the present application after this amendment cancels claims 2 and 3. Claims 1, 6, 7, 9, and 10 are amended by this amendment. No new matter is added by the amendments, which are supported throughout the specification and figures. In particular, the claim amendments are supported in the specification at least at paragraph 0081 of the published application. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

Applicants gratefully acknowledge receipt from the Examiner of the USPTO's translation of Japanese Publication No. 10-172147 to Toru (hereinafter referred to as Toru).

Applicants note with appreciation that the Examiner acknowledges that claims 7 and 9 are directed to patentable subject matter. Claims 7 and 9 are amended herein into independent form, and therefore each of these claims is in condition for allowance.

The Examiner asserts that figures 1 and 2 should be designated by a legend as "Prior Art". Figures 1 and 2 are amended herein to include the designation "Prior Art" and are labeled "Replacement Sheet". Therefore, it is respectfully requested that the objection be withdrawn.

Claims 1-4 and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by United States Patent Publication No. 2002/0159343 to Fujimoto (hereinafter referred to as Fujimoto). Applicants respectfully traverse.

Claim 1 is directed to an optical disk reproducing device that includes, *inter alia*, an optical head for receiving a spot light after being reflected on the optical disk and a signal generating section for generating a comparison reference signal from an output signal of the optical head. The optical disk reproducing device of claim 1 also includes a comparing section for comparing the comparison reference signal with a predetermined threshold value and

generating a comparison signal containing at least one of a first signal status corresponding to the first area and a second signal status corresponding to the second area, and a control section for observing signal status of the comparison signal at least throughout a duration during which the spot light goes round once on the optical disk, and making a decision, based on the observed result, about in which of the first area and the second area the spot light falls. In the device of amended claim 1, the control section makes a decision on whether the first signal status was sustained at least throughout a duration during which the spot light went round once on the optical disk, based on the observed result, and the control section controls the optical head so as to activate a tracking servo when the control detects that the first signal status was sustained at least throughout a duration during which the spot light went round once on the optical disk. Furthermore, in the device of amended claim 1, the *comparing section generates the comparison signal containing both of the first signal status and the second signal status at the case that the spot light travels through the first and second areas throughout a duration during which the spot light goes round once on the optical disk.*

The Examiner asserts that all of the features of claim 1 are disclosed in Fujimoto, and in particular cites figures 16A and 16B and paragraphs 0079, 0080, 0124, and 0125. These sections of Fujimoto apparently disclose distinct areas of a disk, detection of an output signal from the disk, and comparing the signal to a prescribed amplitude signal level. However, Fujimoto does not disclose or suggest *a comparison signal that contains both a first signal status and a second signal status*, as recited in amended claim 1. Therefore, since Fujimoto does not disclose or suggest all of the features of amended claim 1, the claim is allowable over the reference.

Claim 4 depends from claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 10 has been amended to include a feature similar to the feature discussed above in regard to claim 1, and therefore claim 10 is allowable for at least the same reasons as claim 1 is allowable.

Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Fujimoto in view of Toru. Applicants respectfully traverse.

The addition of the Toru fails to cure the critical deficiency of Fujimoto as applied against claim 1, as discussed above. Therefore, since claims 5, 6, and 8 depend from claim 1, each of these claims is allowable for at least the same reasons as claim 1 is allowable.

Additionally, the motivation to combine the references is improper. The Examiner asserts that Toru provides a motivation to combine the references, but merely provides a citation to Toru that apparently discusses the function of Toru. (Office Action; page 7, lines 9-10; citing Toru; paragraph 0023). However, this conclusory reasoning is insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). It is respectfully submitted that the purported advantages of Toru, as discussed in Toru, do not provide a motivation to combine that reference with Fujimoto. Therefore, it is respectfully submitted that the alleged motivation to combine the references is

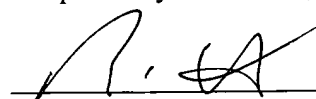
improper and results from hindsight reasoning, and therefore the rejections made on the basis of the combination of the references should be withdrawn.

Additionally, as regards claim 8, neither Fujimoto nor Toru discloses or suggests a comparing section that generates the comparison signal which takes the first signal status when the comparison reference signal exceeded the predetermined threshold value, and takes the second signal status when the comparison reference signal came short of the predetermined threshold value. Therefore, for at least this additional reason, claim 8 is allowable over the references.

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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